

Remarks

The non-final Office Action dated March 5, 2009, notes an objection to claim 11 as being of improper dependent form for failing to further limit the subject matter of a previous claim and an objection to the drawings. The following rejections are presented: claims 1-11 stand rejected under 35 U.S.C. § 102(b) over Cato (U.S. Patent No. 5,539,394); and claims 1 and 6 stand rejected under 35 U.S.C. § 112(1). In this discussion set forth below, Applicant does not acquiesce to any rejection or averment in this Office Action unless Applicant expressly indicates otherwise.

Applicant respectfully traverses the § 102(b) rejection of claims 1-11 because the '394 reference does not correspond to the claimed invention. In certain embodiments, the claimed invention is directed to generating a hash value that identifies a part of a serial number (*e.g.*, a distinguishing dataset) that is stored in a transponder. The transponder uses the generated hash value to access the part of the serial number and then uses that part to calculate the number of a time slot (*e.g.*, a transmission parameter) during which the serial number stored in the transponder is to be transmitted to a communication station. *See, e.g.*, Figure 1 and paragraph 0042 of Applicant's specification. Applicant enables the transponder to determine when to transmit the serial number to the communication station in a self contained manner, which does not require the communication station to transmit the hash value to the transponder. *See, e.g.*, paragraph 0004 of Applicant's specification. In contrast, the '394 reference requires that a reader first transmit a set of parameters (including a hashing base number) to a tag in order for the tag to determine the time slot in which the tag will transmit. *See, e.g.*, Col. 5:29-55. The hashing number of the '394 reference that is calculated in the tag (using the hashing base number) is the time slot in which the tag will transmit. As such, the hashing number of the '394 reference does not correspond to Applicant's hash value, which is used to access a part of the distinguishing dataset (*e.g.*, a serial number), with the accessed part then being used to calculate a transmission parameter (*e.g.*, a time slot). The '394 reference does not teach generating such a hash value, using the generated hash value to access a part of the serial number, and then using the accessed part to determine the time slot. Instead, the '394 reference divides the tag's serial number by the hashing base number (provided by the reader) to determine the hashing number which corresponds to

the time slot in which the tag will transmit its serial number to the reader. *See, e.g.*, Col. 5:48-55. Thus, the '394 reference does not correspond to the claimed invention. Accordingly, the § 102(b) rejection of claims 1-11 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the § 112(1) rejection of claims 1 and 6 because these claims are fully supported by Applicant's specification in compliance with the written description requirement. The Office Action erroneously asserts that Applicant's distinguishing dataset and Applicant's identifying dataset must be the same and both must be the serial number. In contrast, Applicant's specification expressly states that the distinguishing dataset and the identifying dataset are preferably the same but they may be different from one another. *See, e.g.*, Paragraph 0014. For example, Paragraph 0013 states that the distinguishing dataset is preferably the serial number of the transponder but it may also be a so-called user dataset. Thus, Applicant's specification clearly supports the distinguishing dataset and the identifying dataset being the same (*e.g.*, the serial number of the transponder) as well as the distinguishing dataset and the identifying dataset being different. Applicant notes that claims 1 and 6 do not specify whether the distinguishing dataset and the identifying dataset are the same or different. Accordingly, the § 112(1) rejection of claims 1 and 6 is improper and Applicant requests that it be withdrawn.

Applicant respectfully traverses the objection to the drawings because the objection relies upon an improper interpretation of the U.S.P.T.O. rules. Specifically, the Office Action erroneously asserts that the drawings "must show every element of the claimed subject matter." Although the Office Action fails to provide any support for this assertion, it appears that the objection is based on 37 C.F.R. § 1.83(a), which is directed to showing claimed features in the figures, not "every element" as asserted by the Office Action. The definition of a feature is a prominent attribute or aspect of something. In this instance, the specific aspects identified as missing (*i.e.*, a communication station and a random number generator), while possibly relevant, are not prominent attributes or aspects. Rather than limit the cited rule to prominent aspects of the claims, the Office Action appears to take the position that the figures must provide a near word-for-word correspondence to the claims. The Office Action's position, if applied to all cases, would

ostensibly require that every patent application contain a near word-for-word replication of all language from the claims into the figures. Moreover, Applicant's position is also supported by a number of U.S. laws, U.S.P.T.O. rules and passages of the M.P.E.P. This support is largely inconsistent with the Office Action's position and will be discussed hereafter.

The Office Action's apparent interpretation of 37 CFR § 1.83(a) is contrary to the U.S.P.T.O. practice, U.S. law and the M.P.E.P. In support of Applicant's position reference is made to 35 USC § 113 and M.P.E.P. § 601.01(f), which indicate that "applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." The authority for the U.S.P.T.O. to create rules such as 37 C.F.R. § 1.83(a) is derived from 35 USC § 113. Accordingly, 37 C.F.R. § 1.83(a) must be interpreted in light of this law to ensure that the U.S.P.T.O. does not exceed the statutory authority granted by the U.S. Congress. Moreover, M.P.E.P. § 608.02(e) clarifies how 37 C.F.R. § 1.83(a) should be interpreted and applied by an examiner: "The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail *that is essential for a proper understanding of the disclosed invention* should be shown in the drawing." (*emphasis added*). This language is the suggested paragraph for an examiner that wishes to use a 37 C.F.R. § 1.83(a) objection. The Office Action has not used this language, choosing instead to ignore the second half of the suggested language. In addition, M.P.E.P. § 601.01(f) indicates that it has been U.S.P.T.O. practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC § 113.

Referring now to the claim language at issue, Applicant notes that claims 1-6 are method claims that necessarily do not include any structural limitations such as a communication station and a random number generator. In other words, while such aspects are recited in certain ones of claims 1-6, they are not part of the claimed subject matter. Regarding claims 7-11, these claims are directed to an integrated circuit for a transponder and, as such do not include a communication station as part of the claimed subject matter. With regard to the random number generator of claim 10, Applicant

submits that it is not a prominent aspect of the claims and, thus need not be shown in Figure 1. Accordingly, the objection to the drawing is improper and must be withdrawn.

Regarding the objection to claim 11, Applicant has amended claim 11 to recite a transponder that includes the integrated circuit of claim 6 and a transmission coil connected to the integrated circuit. Thus, Applicant requests that the objection to claim 11 be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, David Cordeiro, of NXP Corporation at (408) 474-9063 (or the undersigned).

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